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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,155	04/12/2004	Robert L. Bailey	18602-07958	4566

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APPLE/FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

RAY, GOPAL C

ART UNIT	PAPER NUMBER
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2111

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/823,155

Applicant(s)

BAILEY ET AL.

Examiner

Gopal C. Ray

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2111

1. The requirement for restriction/election mailed on 12/5/06 with some clarification is shown below:

“Claims 1-12 are presented for examination. However, restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, drawn to “a computer-implemented method for dynamically allocating a device to a bus”, Classified in Class 710, Subclass 305.

II. Claim 12, drawn to “a computer bus management system comprising a switch to connect one of the buses to a device in response to performance criteria”, Classified in Class 710, Subclass 316.

Inventions I and II are related as apparatus and process for its practice. They fall under different categories of invention. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). The process as claimed in invention I, claims 1-11 can be used in another materially different apparatus such as any Computer Network, Multi-computer data transferring system, Multiplex communication system and does not limit to application using solely Group II apparatus, Classified in Class 370, Subclass 254; Class 709, Subclasses 235 & 239, etc.

2. Because inventions I and II are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and also require an extra search, restriction of claims (1-11) and 12 for examination purposes is proper. Invention I requires search of 710/305; 709/235, 239 and 713/320 which is not required for invention II.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
4. Applicant should cancel the claims of non-elected inventions. However, applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h)".
5. Applicant's election with traverse of Group I, claims 1-11 in the reply filed on 1/5/07 is acknowledged. The traversal is on the ground(s) that 1) "the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required". This is not found persuasive because Group I, claims 1-11 and Group II, claim 12 require completely different searches. Claims 1-11 require redundant paths to devices whereas claim 12 simply connects different paths; 2) "First, in a restriction of this type (apparatus and process), the examiner must demonstrate that either the process as claimed can be practiced by another materially different apparatus or by hand, or the apparatus as claimed can be used to practice another and materially different process". Apparatus of invention II is not required for the process of Invention I. Apparatus and method have no relationship. Device allocation to a bus, i.e., Invention I is not a simple path selection; i.e., Invention II 3) "Further, even if the examiner meant to say that "network device" could perform the method, this is simply too general of a statement". This is not found persuasive because the process claimed in claims 1-11 can be used in any

Computer Network, Multi-computer data transferring system, Multiplex communication system and does not limit to application using solely Group II apparatus.

Invention I requires search of 710/305; 709/235, 239 and 713/320 which is not required for invention II.

The requirement is still deemed proper, claim 12 stands restricted and is therefore made FINAL.

6. Applicant should cancel non-elected claim 12. Claims 1-11 are presented for examination

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The examiner believes that the title of the invention is broad. A descriptive title indicative of the invention will help in proper indexing, classifying, searching, etc. See MPEP 606.01. However, the title of the invention should be limited to 500 characters.

8. The drawings filed on 4/12/04 are acceptable by the examiner for examination purposes. However, the Office of Initial Patent Examination (OIPE) reviews drawings initially for publication purposes. Direct any inquiries concerning drawing review for publication purposes to the Office of Initial Patent Examination (OIPE). See MPEP 507 for detail information.

9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Furthermore, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.

10. Claims 1-11 are allowable over the prior art of record.

The following is an Examiner's Statement of Reasons for Allowance:

The claimed invention is directed to "devices switchable between buses". The examiner has done complete search and found no prior art, alone or in combination, teaches or fairly suggests the limitation, "automatically selecting a device from a plurality of devices to move from a first of the plurality of buses to a second of the plurality of buses ; and configuring the device to communicate via the second bus" in combination with the other claimed elements as claimed in independent claim 1 and at least similar limitations in independent claims 6 and 10. Dependent claims 2-5, 7-9 and 11 further limit the subject matter of the respective parent claims. Therefore, the invention as claimed in claims 1-11 is considered allowable because combinations recited in the claims are patentably distinguished from the prior art of record.

Any comments considered necessary by applicant must be submitted in response to this office letter in order to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure.

If applicants are aware of any prior art better than those are of record, they are required to bring the prior art to the attention of the examiner. Applicants are also reminded that each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in 37 CFR 1.56. Applicants are advised to submit any information material to patentability in accordance with 37 CFR 1.97 and 1.98.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (571) 272-3631. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (571) 272-3632. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mark.rinehart@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC central telephone number is (571) 272-2100. Moreover, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lastly, paper copies of cited U.S. Patents and Patent Application Publications ceased to be mailed to applicants with office actions as of June 2004. Paper copies of Foreign Patents and Non-Patent Literature will continue to be included with office actions. These cited U.S. Patents and Patent Application Publications are available for download via Office's PAIR. As an alternate source, all U.S. Patents and Patent Application Publications are available on the USPTO web site (www.uspto.gov), from the office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. Patent or Patent Application Publications will not be granted.

Gopal C. Ray
GOPAL C. RAY
PRIMARY EXAMINER
GROUP 2100